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By E-Filing

The Honorable Denis R. Hurley
United States District Court
100 Federal Plaza
Central Islip, NY 11722

Re: *Robert Novak v. Overture Services Inc. et al.*
Case No. CV 02 5164

Your Honor:

Pursuant to your Individual Practice Rules and Federal Rule of Civil Procedure 12(c), Defendant Google, Inc. ("Google") hereby requests a pre-motion conference in advance of a motion for judgment on the pleadings dismissing the Complaint against Google in its entirety. Google believes that a dispositive motion at this time will allow the parties to avoid a considerable expenditure of time, money and judicial resources on a case that does not merit it.

Background

Plaintiff Robert Novak claims ownership of the phrase "pets warehouse" as a trademark. His complaint challenges Google's search engine advertising program and, in particular, a common Internet practice known as "keyword advertising." In response to users' search queries on Google's popular Internet search engine, Google produces a search results page listing hyperlinks to web pages it believes are relevant to the users' queries. Google funds this free search engine by selling advertising space on the search results pages. Under the Google keyword advertising program, advertisers can ask to have their ads displayed whenever Google users enter specific search terms. Thus, for example, a local eatery might pay to have its advertisement appear whenever a user searches via Google for the phrase "Islip Restaurants." Google would generate a page of search results for that phrase and would also present in a separate section of the page an advertisement clearly marked as a "Sponsored Link."

Mr. Novak claims that when these clearly identified "Sponsored Link" advertisements are displayed in response to users' search queries for the phrase "pets warehouse," Google is infringing his supposed trademark rights, and is committing

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related tortious acts.[1] Even accepting Mr. Novak's dubious claims to ownership of a protectable trademark in "pets warehouse," his causes of action against Google are untenable.

Grounds for Dismissal of Lanham Act Claims

Not all "uses" of a trademark are actionable. Courts have long recognized that "[a] trade-mark only gives the right to prohibit the use of it so far as to protect the owner's good will against the sale of another's product as his." *Prestonettes, Inc. v. Coty*, 264 U.S. 359, 368 (1924) (Holmes, J.). Simply put, a defendant "can infringe [a trademark owner's] rights only if [the defendant's] use was a 'trademark use,' that is, one indicating source or origin." *Pirone v. MacMillan, Inc.*, 894 F.2d 579, 583 (2d Cir. 1990); *see also Interactive Prods. Corp. v. a2z Mobile Office Solutions, Inc.*, 326 F.3d 687, 695 (6th Cir. 2003) ("If defendants are only using [plaintiff's] trademark in a 'non-trademark' way—that is, in a way that does not identify the source of a product—then trademark infringement and false designation of origin laws do not apply."). Counts 4 -7 and 11 of Mr. Novak's complaint, alleging various violations of the federal Lanham Act, fail because Mr. Novak has not alleged (and cannot show) that Google is "using" the phrase "pets warehouse" in a trademark sense to brand its own services.

Grounds for Dismissal of Other Claims

Mr. Novak's remaining claims fail either because they similarly rely on Google having violated Novak's trademark rights, or because they are otherwise insufficient.

Counts 8, 11 and 13 asserting trademark infringement and dilution claims under state law fail for the same reason that Mr. Novak's claims under the Lanham Act fail – Mr. Novak cannot allege that Google has made trademark use of "pets warehouse" to promote its own search services. *Allied Maint. Corp. v. Allied Mech. Trades, Inc.*, 42 N.Y.2d 538, 545-46 (1977). Count 13 also fails because it relies upon a superseded provision of the General Business Law.

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[1] Mr. Novak's complaint includes 13 Counts. Google successfully moved to dismiss the claims in Count 1 against Google. *See Order,* March 25, 2004. Count 2 of the complaint, which seems to be a general overview of the alleged trademark infringement underlying the remaining counts, is subsumed by the remaining counts, which set forth the same allegations. Count 3 is not directed at Google. The proposed motion is therefore leveled at Counts 4 through 13, which are directed against Google. A judgment in Google's favor will dispose of this action, in its entirety, as to Google.

Because Mr. Novak has not alleged any specific business relationships with which Google has interfered, Mr. Novak's claim for tortious interference with prospective business advantage (Count 9) fails as a matter of law. *Bus. Networks of N.Y., Inc. v. Complete Network Solutions, Inc.*, 696 N.Y.S.2d 433, 435 (App. Div. 1999). The tortious interference claim also fails because there is no allegation (nor can there be) that Google has used unlawful or improper means – as opposed to pursuit of its own economic ends – to interfere with Mr. Novak's business opportunities. *Guard-Life Corp. v. Parker Hardware Mfg. Corp.*, 50 N.Y.2d 183 (1980). Moreover, Section 230 of the Communications Decency Act provides immunity to Google for any civil, non-intellectual property claim that seeks to hold the company, as an interactive computer service, liable for content provided by a third party. 47 U.S.C. §§ 230(c)(2), (e)(2).

As to the claim for unjust enrichment under New York law (Count 10), Mr. Novak has not shown, and cannot hope to show, that he performed services on behalf of Google. Thus, this claim cannot stand. *Clark v. Daby*, 751 N.Y.S.2d 622, 623-24 (App. Div. 2002).

Count 12 is a claim for deceptive acts and practices under Sections 349 and 350 of New York's General Business Law. Given the lack of any allegations in the Complaint of specific and substantial injury to the public – extending beyond alleged infringement or dilution of Mr. Novak's own trademark rights – these claims are legally insufficient. *National Distillers Prods. Co., LLC v. Refreshment Brands, Inc.*, 198 F. Supp. 2d 474 (S.D.N.Y. 2002).

The claims against Google are also barred, in whole or in part, because Google is an innocent publisher pursuant to federal and state law. 15 U.S.C. § 1114(2); N.Y. G.B.L. § 349(e).

Conclusion

For these reasons, Google requests leave to move for judgment on the pleadings, or in the alternative, for summary judgment. Because we are located in California, we respectfully request leave to participate in the pre-motion conference telephonically.

Respectfully submitted,

/s/ John L. Slafsky

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